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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 08/05/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,566

Applicant(s)

BECKER, THOMAS

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 21 May 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on May 21, 2003. These drawings are approved.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 18, 20, 22-25, 29, 30, 32-36, 41, 45-47, 51, 52, 54-58, 65-67, 71, 75, 76 and 78-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez (3,986,283) in view of Gick et al. (5,735,453).

Pelaez discloses an advertisement device (10) for direct mail delivery to a recipient comprising a synthetic panel (see col. 1, lines 59-64), having a back side (as seen in figures 4 and 5), a front side (as seen in figure 1) having decorative or humorous material (11), at least one of the back side and the front side having indelible printing (see col. 1, lines 64-68 through col. 2, lines 1-11 and col. 2, lines 36-40) and having a thickness sufficient to maintain integrity of the synthetic panel (as seen in figure 3).

Pelaez discloses the claimed invention except for the synthetic panel being non-rectangular.

Gick et al. disclose decorative novelty articles comprising a postcard (10) cut from a sheet (24) having a back side having indelible printing (as seen in figure 3), a front side (as seen in figure 1) and a thickness sufficient to maintain integrity of the panel (as seen in figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to provide the synthetic panel in a non-rectangular shape, as taught by Gick et al., to provide the advertisement device with an esthetically pleasing appearance for the promotion of a particular item and/or service. Furthermore, It would have been an obvious matter of design choice to make the different portions of the synthetic panel of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Regarding claim 2, Pelaez, as modified by Gick et al., discloses delivery information directly on the back side of the synthetic panel (as seen in figure 3 of Gick et al., delivery information "From" and "To" is printed on the back side of the postcard).

Regarding claim 3, Pelaez, as modified by Gick et al., discloses the delivery information being preprinted on a separate label (21 – printed paper backing) and applied to a surface of the back side of the synthetic panel (see col. 2, lines 41-53).

Regarding claim 4, Pelaez, as modified by Gick et al., discloses the synthetic panel comprising a theme related to a product (as seen in figure 1 of Gick et al., the decorative article postcard has a design 14 of a product in the form of a flower).

Regarding claim 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired synthetic material for the panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 20, Pelaez, as modified by Gick et al., discloses the post card being made of an injection molded synthetic plastic material (see col. 1, lines 59-64 of Pelaez).

Regarding claims 22-25, Pelaez, as modified by Gick et al., discloses means (15 – adhesive strip assembly in the form of a pressure-sensitive adhesive material 18 covered by a protective cover strip 19) to attach the device to a surface (see col. 2, lines 20-35 of Pelaez).

Regarding claims 29, 30 and 32, Pelaez, as modified by Gick et al., discloses a mechanism (15) to carry another item (see col. 2, lines 20-35 of Pelaez – “...or other smooth surface...”). The item, inherently, could include one of a coupon, a business card, a credit card and a refrigerator magnet since these items have at least one smooth surface.

Regarding claims 33-36, 41, 45-47, 51, 52 and 54, the method of delivering an advertisement device by direct mail delivery to a recipient is inherently disclosed in the above rejections.

Regarding claims 55 and 56, Pelaez, as modified by Gick et al., discloses the advertisement device system as set forth above. Pelaez, as modified by Gick et al.,

Art Unit: 3722

discloses means for applying the delivery information ("such as by running an inking roller over the face of the card..." – see col. 1, lines 67-68 through col. 2, lines 1-3 and col. 2, lines 36-40 of Pelaez).

Regarding claims 57, 58, 65-67, 71, 75, 76 and 78, see the above rejections.

Regarding claim 79, Pelaez, as modified by Gick et al., disclose the advertisement device for direct mail delivery to a recipient as set forth in the above rejections.

Regarding claims 80-82, Pelaez, as modified by Gick et al., discloses the synthetic panel having a non-porous surface adapted for receiving printing inks and the synthetic panel being made of a memory shape-retaining material (see col. 1, lines 3-8 and 59-68 through col. 2, lines 1-8 of Pelaez).

Regarding claims 83-85, Pelaez, as modified by Gick et al., disclose the claimed advertisement device as set forth in the above rejections.

Regarding claims 86-89, the method of delivering an advertisement device by direct mail delivery to a recipient is inherently disclosed in the above rejections.

Regarding claim 90, Pelaez, as modified by Gick et al., discloses an advertisement device for direct mail delivery to a recipient as set forth above. The sheet of synthetic material being formed without molding does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Art Unit: 3722

2. Claims 5-13, 26-28, 38-40, 48-50, 59, 61-64 and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez in view of Gick et al. and further in view of Buchler (4,506,823).

Pelaez, as modified by Gick et al., discloses the claimed invention except for the synthetic panel having an embedded cutout cut (by either die cutting, knife cutting) from a synthetic sheet.

Buchler discloses a plurality of non-rectangular letter cards (402, 502, 602) having holes (402b, 502b) for suspension of the cards on a nail, hook or the like (see col. 9, lines 63-68 through col. 10, lines 1-3). The outline of the cards can resemble a flower, a bell, a flag, a church, etc., "so that the appearance of the card is suggestive of its purpose (e.g., condolence or birthday celebration)." (see col. 10, lines 3-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to include non-rectangular card having a cutout, as taught by Buchler, to display the cards in a retail store, at home on the wall, or similar places.

Note: The use of grommets in holes is conventional in the art and it would have been obvious to one having ordinary skill in the art to provide a grommet in the hole of Pelaez, as modified by Gick et al. and Buchler.

Regarding claim 11, Pelaez, as modified by Gick et al. and Buchler, discloses using various colors for printing an image on the panel (see col. 2, lines 3-11 of Pelaez). Furthermore, matters related to the choice of ornamentation producing no mechanical

effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. *In re Seid*, 73 USPQ 431.

Regarding claim 13, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the same printed pattern on the front and back sides of the synthetic panel, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

3. Claims 14-17, 19, 21, 37, 42-44 and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez in view of Gick et al. and further in view of Aamodt et al. ('969).

Pelaez, as modified by Gick et al., discloses the claimed invention except for the device having an anti-microbial agent.

Aamodt et al. disclose a paper material that can be impregnated with at least one chemical material. In one embodiment of Aamodt et al. the paper is impregnated with a gaseous peracetic acid that diffuses out of pores in the paper, creating a no-growth zone on the surface of the paper (see col. 1, lines 10-17, 28-35 and 51-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to include an anti-microbial agent on the panel, as taught by Aamodt et al., to provide a "paper product which can inhibit the growth of microorganisms..." (see col. 1, lines 47-49).

Art Unit: 3722

4. Claims 31, 53 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez in view of Gick et al. and further in view of Huff et al. (6,499,654).

Pelaez, as modified by Gick et al., discloses the claimed invention except for the mechanism to carry another item comprising a shrink wrap to hold the item to the device.

Huff et al. disclose a postcard (100) for carrying a disk medium comprising a front side (1114) having a first area (116) and a second area (118). In a preferred embodiment, a label is attached to the back side of the postcard and the means for attaching the disk medium may be located on the back side of the postcard. The second area includes a pocket (120) attached to the postcard. The pocket is formed from a sheet (126) of thin flexible transparent plastic material. A thin transparent, film of plastic (130) is snugly attached to the postcard by a shrink wrap process. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to include a pocket shrink-wrapped to the card, as taught by Huff et al., to provide a means for securely carrying additional items in combination with the postcard for delivery to a recipient.

5. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pelaez, in view of Gick et al. and Buchler and further in view of Aamodt et al.

Pelaez, as modified by Gick et al. and Buchler, discloses the claimed invention except for the device having an anti-microbial agent.

Aamodt et al. disclose a paper material that can be impregnated with at least one chemical material. In one embodiment of Aamodt et al. the paper is impregnated with a gaseous peracetic acid that diffuses out of pores in the paper, creating a no-growth zone on the surface of the paper (see col. 1, lines 10-17, 28-35 and 51-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Pelaez's invention to include an anti-microbial agent on the panel, as taught by Aamodt et al., to provide a "paper product which can inhibit the growth of microorganisms..." (see col. 1, lines 47-49).

Response to Arguments

6. Applicant's arguments with respect to claims 1-90 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

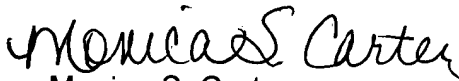
Art Unit: 3722

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Monica S. Carter
Primary Examiner
Art Unit 3722

July 29, 2003